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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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27572	7590	11/03/2006	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				GILLIGAN, CHRISTOPHER L
ART UNIT		PAPER NUMBER		
				3626

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/844,102	COLBURN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Luke Gilligan	3626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS,  
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 09 August 2006.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,4-6,8,9,11-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 4-6, 8-9, 11-13, and 15-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application  
6) Other: \_\_\_\_\_.

***Response to Amendment***

1. In the amendment filed 8/9/06, the following has occurred: claims 1, 4, 6, and 11-12 have been amended. 1, 4-6, 8-9, 11-13, and 15-17 are presented for examination.
2. The rejections under 35 U.S.C. 112 have been withdrawn by the Examiner based on changes made by Applicants to the claims.
3. The amendment filed 8/9/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "utilizing a computer to recursively closely monitor a specific case..." as recited in amended claim 1.
4. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 1 and 4-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 3626

7. Amended claim 1 recites the phrase "utilizing a computer recursively monitor a specific case..." in the final step. There is no mention in the originally filed specification of "recursively" monitoring a specific case.
8. Claims 4 and 5 contain the same deficiencies as claim 1 through dependency.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner) in view of DiRienzo, U.S. Patent No. 6,003,007.

11. As per claim 1, Fernberg discloses a method of optimizing a workers' compensation claims management process, which contains files relating to a workers' compensation claim of an injured or ill individual comprising the steps of: reviewing the workers' compensation claims management process to determine if best practices are being followed (see paragraphs 22 and 23, in particular, the disclosed consulting and benchmarking are types of reviewing to determine best practices); amending the workers' compensation claims management process by implementing the best practices into the workers' compensation claims management process (see paragraph 24); monitoring the amended workers' compensation claims management process to determine if the best practices are being followed (see paragraph 25, in particular the continuous reevaluation of the program); and recursively closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices

Art Unit: 3626

are not being followed and to generate a report indicative thereof (see paragraphs 28-30, the Examiner interprets the "claims loss runs" to by a type of report).

10. Although Fernberg does teaches certain best practices such as a report must include all known facts (see paragraph 29), Fernberg does not explicitly teach all of the items that are listed as best practices. However, listed items appear to be merely abstract conditions, such as "at the time of the review of the file the reserves should reflect an expected value based on the known facts," that do not functionally relate to the method steps. Therefore, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). In addition, it is respectfully submitted that the conditions that are listed under "best practices" are all old and well known in the art of workers compensation claims management processing.

11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to list any data as the conditions for "best practices" because such data does not functionally relate to the recited method steps and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

12. In addition, Fernberg does not explicitly disclose the use of a computer for closely monitoring a specific case. However, DiRienzo teaches an insurance claims processing system that includes the feature of computer monitoring specific claims cases (see column 22, lines 25-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate computer hardware, as is standard in the industry, into method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate a computer

Art Unit: 3626

for the purpose of increasing the speed and efficiency of claims processing as is standard in the industry (see column 2, lines 38-41 of DiRienzo).

13. As per claim 5, Fernberg discloses the method of claim 1 as described above. Fernberg further discloses the best practices at includes timely and appropriate assignment of light duty work (see paragraph 36, in particular, the Examiner is relying on the disclosure of the modified duty program). Although Fernberg does not explicitly teach all of the listed best practices, such non-functional conditions do not distinguish the claimed invention from the prior art as described above with respect to claim 1.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner) in view of DiRienzo, U.S. Patent No. 6,003,007 and further in view of Hammond et al., U.S. Patent No. 5,712,984.

15. As per claim 4, Fernberg in view of DiRienzo teach the method of claim 1 as described above. Fernberg does not explicitly disclose the listed best practices. Hammond teaches a method for funding workers' compensation losses that at least includes the practice of properly documenting reserve changes within a file and reserve history (see column 14, lines 27-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the ability of insurers and employers to more accurately budget and forecast (see column 2, lines 6-11 of Hammond).

Art Unit: 3626

16. In addition, although neither Fernberg nor Hammond explicitly teach all of the listed best practices, such non-functional conditions do not distinguish the claimed invention from the prior art as described above with respect to claim 1.

17. Claims 6, 8, 9, 11-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner) in view of DiRienzo, U.S. Patent No. 6,003,007 and Anthony, **Workers' compensation fraud** (hereinafter Anthony, paragraphs numbered by Examiner) and further in view of Ahmad, U.S. Patent No. 6,089,974.

18. As per claim 6, Fernberg discloses a method of optimizing a workers' compensation claims management process, which contains files relating to a workers' compensation claim of an injured or ill individual comprising the steps of: determining whether a claim is classified as a high risk (see paragraphs 34 and 38, in particular, determining whether there is potential for fraud is a type of "high risk" claim); conducting a three point interview within 72 hours of an injury (see paragraphs 28-31, in particular, the Examiner notes that Fernberg discloses conducting interviews with the employee, supervisor, and medical provider and discloses that it is favorable to conduct reporting within 48 hours); and monitoring a claim at periodic intervals (see paragraph 35).

19. Fernberg does not explicitly teach disclose the listed questions. Anthony discloses a method for avoiding workers' compensation fraud that includes at least asking questions about the incident that caused the injury (see paragraph 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of helping to further document inconsistencies and provide clues

that could warrant a more detailed investigation (see paragraph 7 of Anthony). In addition, although neither Fernberg nor Anthony explicitly teach all of the listed questions, they appear to merely be abstract statements that do not functionally relate to the claimed method steps. Therefore, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). In addition, it is respectfully submitted that these types of questions are all old and well known in the art of workers compensation claims management processing.

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to list any data as the questions because such data does not functionally relate to the recited method steps and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

21. Fernberg does not explicitly teach that a nurse conducts the interview. However, Ahmad teaches the practice of a nurse interviewing a patient for insurance claims processing purposes (see column 2, line 66 – column 3, line 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the use of a nurse for conducting interviews in the method of Fernberg. One of ordinary skill in the art would have been motivated to do this for the purpose of taking advantage of medical professionals who know what questions to ask injured workers (see paragraph 31 of Fernberg).

22. Fernberg also does not explicitly disclose the use of a computer for monitoring a claim. However, DiRienzo teaches an insurance claims processing system that includes the feature of computer monitoring claims (see column 22, lines 25-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate computer hardware, as is

Art Unit: 3626

standard in the industry, into method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate a computer for the purpose of increasing the speed and efficiency of claims processing as is standard in the industry (see column 2, lines 38-41 of DiRienzo).

23. As per claim 8, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as high risk includes asking a supervisor a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning supervisors is a part of the process of determining the potential for fraud).

24. As per claim 9, Fernberg , Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as high risk includes asking a medical professional a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning medical professionals is a part of the process of determining the potential for fraud).

25. As per claim 11, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 8 as described above. As described above, although neither Fernberg nor Anthony explicitly teach all of the listed questions such non-functional data does not distinguish the claimed invention from the prior art as described above with respect to claim 6.

26. As per claim 12, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 9 as described above. As described above, although neither Fernberg nor Anthony explicitly teach all of the listed questions such non-functional data does not distinguish the claimed invention from the prior art as described above with respect to claim 6.

Art Unit: 3626

27. As per claim 13, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Claim 13 recites substantially similar additional limitations to those already addressed in claim 1 and, as such, is rejected for similar reasons as given above.
28. As per claim 15, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).
29. As per claim 16, Fernberg, Ahmed, Anthony, and DiRienzo disclose the method of claim 6 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).
30. As per claim 17, Fernberg, Ahmed, Anthony, and DiRienzo disclose the method of claim 11 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

***Response to Arguments***

31. In the remarks filed 8/9/06, Applicants argue in substance that (1), Fernberg does not teach incorporating a claims audit process in conjunction with the performance evaluation process and subsequent monitoring process; (2) Fernberg fails to recursively review the files; (3) the disclosed best practices are not old and well known in the art of worker's compensation claims management processing and are not abstract conditions that do not functionally relate to the method steps; (4) the references fail to teach providing proper maintenance of reserve funds as recited in claim 4; (5) the references fail to teach recursively prompting the assigned claims adjusters in the application of the best practices; (6) none of the references teach the limitations outlined at pages 13-15 of the remarks; (7) none of the cited references teach conducting an interview within 72 hours if the claim is categorized as high risk; (8) Dirienzo cannot anticipate claim 6 because it does not teach monitoring the claim at periodic intervals
32. In response to Applicants' argument (1), it is unclear exactly what specific limitation is being asserted as not being taught by Fernberg. In particular, neither "claims audit" nor "performance evaluation" appear in the claims. For example, with respect to claim 1, there are only 4 recited steps: "reviewing..." "amending..." "monitoring..." and "utilizing...". It is respectfully maintained that Fernberg in view of Dirienzo teaches each of these steps, as recited in the claims, as set forth in the rejections above.
33. In response to Applicants' argument (2), the Examiner has interpreted the "claims loss runs" of Fernberg to be a form report indicative of the following of best practices from monitoring the claims management process (see paragraph 30). Since it is further indicated that this report is sent regularly, it is respectfully submitted that this is a form of "recursive" monitoring, given the broadest reasonable interpretation of the phrase.

34. In response to Applicant's argument (3), the Examiner respectfully disagrees that the recited best practices are functional limitations as asserted by Applicants. The claims recite various actions and conditions that make up the best practices. However, with respect to claim 1, the conditions and actions do not functionally relate to the recited steps of "reviewing," "amending," "monitoring," and "utilizing." They merely describe practices that are to be included in an amended workers' compensation claims management process. The claims do not, however, actually recite any steps of performing any of these best practices.

35. In response to Applicants' argument (4), it is respectfully submitted that the claim does not require such a step to be performed. Rather, the claim further defines what is included in the best practices. In other words, there is no additional step of providing proper maintenance of reserve funds.

36. In response to Applicants' argument (5), it is again respectfully submitted that the claims do not require such a limitation. There is no mention of "claims adjusters" recited in the claims, much less "prompting" any particular individual to perform any particular action. Therefore, this argument is not found to be persuasive.

37. In response to Applicants' argument (6), it is again unclear what particular recited limitations are being alleged as missing. Applicants' outline numerous aspects of the invention at pages 13 and 14, however, the assertion that "none of the references teach these limitations" (see top of page 15 of the remarks) does not appear to directly correspond to a particular claim limitation.

38. In response to Applicants' argument (7), it is respectfully submitted that Fernberg teaches conducting an interview within 72 hours (i.e. it is favorable to conduct reporting within 48 hours). Fernberg further teaches determining if a claim is high risk (i.e. determining if there is potential for fraud. Since there are certain claims that will be classified as having potential for

fraud in Fernberg, it is respectfully submitted that in this circumstance, the limitation of conducting an interview within 72 hours if the claim is classified as high risk is met.

***Conclusion***

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10/30/06

  
C. LUKE GILLIGAN  
PATENT EXAMINER